

### **REMARKS**

Claims 1-24 are all the claims pending in the application. Please note that this Amendment has been formatted according to the Revised Format Now Permitted and, therefore, waiver of 37 C.F.R. § 1.121 is requested.<sup>1</sup> Reconsideration and allowance of all the claims are respectfully requested in view of the following remarks.

#### **Election/Restriction**

The Examiner has withdrawn claims 7-22 from further consideration pursuant to 37 C.F.R. § 1.142(b) as being drawn to a nonelected invention.

#### **Drawings**

The Examiner objected to the drawings as failing to include reference signs mentioned in the description. Specifically, the Examiner asserted that Fig. 3 does not contain numerals 38, 33, and 46, as set forth on page 7, lines 14-17 of the specification. Applicants respectfully traverse this objection for the following reasons.

The specification does not state that Fig. 3 shows the water supply port 38, the moisture suction port 33, or the opening 46. Instead, the specification describes that Fig. 3 is a top view of the paper making portion 3. Further, the water supply port 38, moisture suction port 33, and the opening 46 are not seen from the top view of the paper making portion 3. Accordingly, it would not appear to be appropriate for Fig. 3 to show the above-noted features. Instead, Applicants have amended the specification to make it more clear that Fig. 3 is a top view of the paper making portion 3, and does not necessarily show the noted elements.

#### **Claim Rejections - 35 U.S.C. § 112**

The Examiner rejected claims 1-6, 23, and 24, under §112, 1<sup>st</sup> paragraph, as based on a disclosure which is not enabling. Specifically, the Examiner asserts that “[t]he device to make

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<sup>1</sup> See Pre-OG Notices as posted on the PTO website at [www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm).

the discontinue body is critical or essential to the practice of the invention, but not included in the claim(s) ...”<sup>2</sup> Applicants respectfully traverse this rejection for the following three reasons.

First, the device to make the discontinuous body is not critical or essential to the practice of the invention. In fact, in the restriction requirement, the Examiner noted that the invention as set forth in claims 1-6 could be “practiced with a material different apparatus, such as using a Fourdrinier wire, i.e., not annular device is required.”<sup>3</sup>

Second, the method of making paper is described in the specification at, for example: page 8, 2<sup>nd</sup> full paragraph; page 10, 1<sup>st</sup> full paragraph, and paragraph bridging pages 10 and 11. Upon reading the description as set forth in the specification, one of ordinary skill in the art would readily understand how to carry out the process. Although exemplary embodiments of an apparatus for making a discontinuous or annular products are described, “only certain embodiments of the invention have been specifically described herein, it will [be] apparent that numerous modifications may be made thereto without departing from the spirit and scope of the invention.”<sup>4</sup> Accordingly, one of ordinary skill in the art would readily recognize that the paper product would not necessarily have to be made using the exemplary apparatuses described in the specification.

Third, the Examiner’s reliance on *In re Mayhew*<sup>5</sup>, is misplaced. In *Mayhew*, the court held that because Mayhew’s specification described the existence and location of a “cooling zone” as an essential feature of the invention, claims directed to a process without the location and existence of the “cooling zone” were unsupported by the specification. In contrast to the situation in *Mayhew*, here, the specification does not describe that the exemplary embodiments of the apparatus are necessary for carrying out the method of the presently claimed invention.

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<sup>2</sup> Office Action at page 2, item 4 (spelling as in original).

<sup>3</sup> Restriction Requirement mailed on July 23, 2002, at page 2, items 1 and 2 (grammar as in original).

<sup>4</sup> Specification at page 13, last full paragraph.

<sup>5</sup> *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Accordingly, the specific features of the exemplary apparatuses need not be recited in the method claims.

For at least any one of the above reasons, the Examiner's rejection is in error, and should be withdrawn.

- The Examiner rejected claims 1-6, 23, and 24, under § 112, 2<sup>nd</sup> paragraph, as indefinite. Specifically, the Examiner asserts that claim 1 is indefinite because there is no physical means to carry out the process, e.g., no physical means to hold the water that is in a stirred condition. Applicants respectfully traverse this rejection as follows.

The claims are not indefinite; they are merely broad. And breadth of a claim is not to be equated with indefiniteness.<sup>6</sup> By not reciting exactly what holds the water that is in a stirred condition, the claims encompass a method using any structure for doing so. That is, the specific features of the apparatus for holding water in a stirred condition are not essential to the method as set forth in claim 1. The definition of the method in such broad terms does not make the claims indefinite.

#### **Claim Rejections - 35 U.S.C. § 102**

The Examiner rejected claims 1-3, 5, 6, 23, and 24, under § 102(b) as being anticipated by JP 2000-063802 to Yasushi (hereinafter Yasushi). Applicants respectfully traverse this rejection because Yasushi fails to disclose every element as set forth in Applicants' claims.

Claim 1 sets forth a method of making a discontinuous paper body, comprising, among other things, feeding a raw material with a predetermined concentration into water which is in a stirred condition. Thus, the water is in a stirred condition, and the raw material is fed into the stirred water. See, for example, page 8, 2<sup>nd</sup> full paragraph.

In contrast to that in claim 1, Yasushi discloses stirring a raw material and then passing it into a lauter tub 30. That is, Yasushi discloses that stirring supply tubs 40a-c contain the raw

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<sup>6</sup> *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971).

material. The raw material is then fed through connecting tubes 60 to funnels 38a-c, and into the lauter tub 30. However, Yasushi fails to teach or suggest that there is any water at all in lauter tub 30, let alone that it is in a stirred condition. Accordingly, Yasushi fails to disclose feeding a raw material with a predetermined concentration into water which is in a stirred condition, as set forth in Applicants' claim 1.

For at least any of the above reasons, claim 1 is not anticipated by Yasushi. Likewise, dependent claims 2, 3, 5, 6, 23, and 24, are not anticipated by this reference.

### **Claim Rejections - 35 U.S.C. § 103**

The Examiner rejected claim 4 under § 103(a) as being unpatentable over Yasushi. Applicants respectfully traverse this rejection because Yasushi fails to teach or suggest all the elements as set forth in Applicants' claims.

The Examiner asserts that Yasushi discloses everything as set forth in Applicants' claim except air nozzles as the stirring mechanism. The Examiner then asserts that it would have been obvious to do so.<sup>2</sup> However, as noted above, Yasushi also fails to disclose feeding a raw material with a predetermined concentration into water which is in a stirred condition. Accordingly, for the sake of argument, even assuming that one of ordinary skill in the art were motivated to modify Yasushi as suggested by the Examiner, any such modification would still not include a step of feeding a raw material with a predetermined concentration into water which is in a stirred condition, as set forth in Applicants' claim 4.

For at least any of the above reasons, claim 4 is not rendered obvious by Yasushi.

### **Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

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<sup>2</sup> Office Action at page 4, item 11.


Amendment Under 37 C.F.R. § 1.111  
U.S. Appln. No. 09/899,601

Atty. Dkty No. Q65349

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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